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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,763	06/28/2006	Henri Rosset	062723	5785
38834 7590 08/21/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER JOY, DAVID J				
ART UNIT 1794		PAPER NUMBER		
NOTIFICATION DATE 08/21/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

### Office Action Summary

**Application No.**

10/584,763

**Applicant(s)**

ROSSET ET AL.

**Examiner**

David J. Joy

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/US)  
Paper No(s)/Mail Date 06/28/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of the invention of Group I, Claims 1-13, in the reply filed on June 18, 2009 is acknowledged. The traversal is on the grounds that the U.S. Patent of Welch et al. (3,256,138; hereinafter "Welch") does not disclose a paper as recited in present Claim 1. This is not found persuasive because Welch clearly recites that "discrete resin particles can be incorporated in the surfaces of fibrous plies, for example, at the wet end of a paper machine." Given that teaching and the definitions provided in the instant specification, it would appear that the *discrete resin particles* could also be described as being in *diffuse* form because the term diffuse is understood to mean that the particles are "dissolved or emulsified in the composition of the layer and [are] distributed diffusely between said plies." Likewise, Welch expressly provides that the particles are incorporated into the wet, fibrous plies, and then those plies are dried, and then the dried paper is heated and calendared. Therefore, the particles can be deemed to be *intimately joined* to the paper plies, given that the expression "being intimately joined together" is understood to mean that "constituents of each of the plies and also those of the composition of the layer are partially interpenetrating."

2. The requirement is still deemed proper and is therefore made FINAL.
3. Claims 14-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on June 18, 2009.

***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Objections***

5. Claim 1 is objected to because of the following informalities: the claim recites the limitation "*diffuse form*". The use of the quotation marks in reciting a claim limitation is not acceptable. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 3 recite the limitation "said layer" in Lines 2 and 3, respectively.

8. Claims 11 and 12 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is indefinite due to the fact that the limitations recited therein are unclear. Specifically, the claim recites that the element reacts to *certain* stimulations giving a *specific* signal that can be detected using a *suitable* device, without providing any definitive details for those limitations.

9. Claim 12 is rejected accordingly, as Claim 12 depends upon Claim 11.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by the U.S. Patent of Williams (3,880,706).

12. Williams teaches a security paper comprising at least two plies, in which at least one interlayer ("the material") placed between the two plies of paper includes an element that is in diffuse form and in the form of particles, and the two plies and the interlayer are intimately joined together (see Abstract; see also Column 1, Lines 9-14; see also Column 2, Lines 45-53; see also Column 2, Line 62 - Column 3, Line 4; see also Column 3, Lines 18-35). Specifically, Williams provides that the particles are deposited onto the wet paper web (i.e., they are distributed diffusely onto the paper ply), that the interlayer material can extend throughout the paper, and that the interlayer material becomes sandwiched between the two webs and mingles locally with the fibrous material of the paper, as the multilayer paper is passed through a press section, a drying zone, and then a calendaring zone (see Column 47-52; see also Column 3, Lines 58-64; see also Column 5, Lines 10-28). Williams also teaches that the interlayer material can be synthetic fibers, such as polyamide and polyethylene, and/or pigment particles,

and that interlayer material can include either type or both types of materials (see Abstract; see Column 1, Line 53 – Column 2, Line 25; see also Column 3, Lines 5-17). In addition, Williams provides that the weight of each paper ply is between 30 and 60 g/m<sup>2</sup> (see Examples 1, 6 and 8).

13. Williams teaches that the paper can include a watermark, and that interlayer material can also include such additional materials as colored pigments, metallic particles, radioactive particles, ferromagnetic particles and fluorescent particles (see Column 1, Lines 15-27; see also Column 2, Line 62 – Column 3, Line 4; see also Column 3, Lines 5-17; see also Column 4, Lines 4-8). Further, Williams provides that the inclusion of these materials will add yet another means of detection, recognition, or counting for authorities who issue or inspect security documents (see Column 4, Lines 4-8).

14. While Williams does not expressly provide that a numerical value for the double-fold resistance of the security paper, due to the fact that Williams teaches a multilayer security paper that is both structurally and compositionally the same as that which is presently claimed, the paper taught by Williams will inherently possess the requisite double-fold resistance. The claiming of a new use, new function or unknown property,

which is inherently present in the prior art, does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause claim language drawn to those things to be distinguishable over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess a characteristic relied upon where it has reason to believe that a functional limitation asserted to be critical for establishing novelty in claimed subject matter may be an inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,716,695

02/1998

Benoit et al.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.



17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on (571) 272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Bruce H Hess/  
Primary Examiner, Art Unit 1794